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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,481	01/23/2004	Dennis Hoffmann SR.	29833/39384	7037

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EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,481	Applicant(s) HOFFMANN ET AL.	
	Examiner Nasser Ahmad	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) 5-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. In response to applicant's request that the invention groups II-V be consolidated into a single divisional application, applicant is reminded that the groups were shown to be independent and distinct in the Office Action of October 5, 2005.

Rejections Withdrawn

2. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Torrey (3741786) made in the last Office Action has been withdrawn in view of the amendment filed on January 30, 2006.
3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey made in the last Office Action has been withdrawn in view of the amendment.

Response to Arguments

4. Applicant's arguments with respect to claims 1 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey.

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Torrey relates to a device comprising a sheet of release paper having a first side coated with first silicone and coated intermittently with pressure sensitive adhesive (PSA). The sheet also has a second side which is coated with silicone and the sheet is provided in a roll form. See col. 1, lines 10-14; col. 1, line 69 to col. 2, line 10; col. 3, lines 20-25; col. 4, lines 24-26 and 37-39. The PSA is in a dotted pattern (figure-1 and col. 3, lines 62-68). The precise configuration of the PSA pattern is not critical as mentioned in col. 3, lines 57-60. However, Torrey fails to teach that the PSA is in a swirl pattern. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Torrey by providing swirl pattern of PSA to form a change in the aesthetic design, because such a change would have involved a mere change in the design of the adhesive pattern. A change in design is generally recognized to be within the level of ordinary skill in the art. *In re Seid*, 73 USPQ 431.

Regarding the preamble phrase "A repair device", it is understood by the examiner that the tape of Torrey would function equally well as a repair device as it can adhere to elements together, such as a wall paper to a wall surface, etc.

Response to Arguments

7. Applicant's arguments filed January 30, 2006 have been fully considered but they are not persuasive.

Applicant argues that Torrey does not teach the PSA in a swirl pattern. This is not found to be convincing because, as mentioned in the last Office Action of November 2, 2005 and restated hereinabove, it would have been obvious to modify Torrey to provide the

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PSA in a swirl pattern, instead of the dotted or other disclosed pattern, for aesthetic appeal, absent any showing of criticality by the applicant.

Applicant should note Torrey also mentions in col. 3, lines 57-60 that the precise configuration of the PSA is not critical.

Further, the originally filed application also mentions, in page-1, paragraph-1, that the adhesive is applied intermittently, such as in a swirl pattern, dot pattern, checkerboard pattern etc. This clearly shows that the swirl pattern is functionally equivalent to the dot or checkerboard pattern. Thus, the particular pattern is not found to be critical as argued by the applicant.

Regarding applicants' arguments about the disadvantages of presence of excess amount of PSA in page-5 of the amendment, applicant is informed that said features could not be located in the claims not in the specification as originally filed, and also cannot be read in the claims for the purpose of overcoming the applied prior art.

As for the argument that Torrey is not a repair device, applicant should note that the structure of Torrey is directed to a transfer PSA tape and it is understood by the examiner that such a transfer PSA tape would function to join surfaces together such as a wall paper to a wall surface. Hence, it would be obvious for Torrey's tape to function as a repair device.

Responding to applicant's arguments that the functional limitations in the last paragraph of claim 1 be given patentable weight, applicant is reminded that functional recitation in said paragraph of claim 1 is directed to an intended use of the claimed product and are not found to be of positive limitation. Hence, said phrases have not been given

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patentable weight. In the alternative, assuming arguendo, that given weight to said last paragraph, applicant has failed to show that the adhesive pattern of Torrey would not result in the transfer of the PSA.

Thus, in the absence of any evidence to the contrary it remains the examiner's position that the claimed invention is obvious over the prior art of record discussed above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

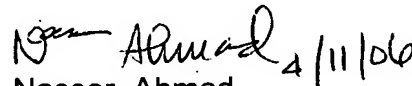
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
April 11, 2006.